

REMARKS

The February 6, 2004, Office action rejected claims 1-4, and 11. To expedite prosecution of this case, this Amendment and Response amends claims 1, 5, 11, 12, and 14, without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of the original claims in co-pending applications. Support for the various amendments may be found in the originally filed specification, claims and figures; no new matter has been introduced. After entry of this amendment, claims 1-14 and 20 remain pending in the application, including three independent claims. In view of the foregoing remarks, reconsideration of the application is respectfully requested.

Claim Rejections under 35 USC §103

In the February 6, 2004, Office action, the Examiner rejected claims 1-4, and 11 under 35 USC §103(a) as being unpatentable over Greaney (U.S. Pat. 5,752,483) in view of Shipinski (U.S. Pat. 4,176,642). For the following reasons, Applicants respectfully traverse the Examiner's grounds for rejection. Reconsideration is requested.

As recited in MPEP §706.02(j), "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

As more fully described below, Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner for at least the reasons that: (1) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of the cited references; and (2) Greaney, Shipinski, and the other cited references fail to teach, hint, suggest or disclose every element of the present invention as disclosed and claimed. Accordingly, Applicants respectfully submit that the Examiner has failed to assert a *prima*

facie case for obviousness, and the Section 103(a) rejections of claims 1-4 and 11 are improper.

First, with respect to previously presented claim 1, Applicants respectfully submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine reference teachings of Greaney and Shipinski. Moreover, Applicants have amended claim 1 to recite that **“the metering valve member has a range of travel including a region of dead travel in which substantially no variation in fuelling of the engine occurs, and wherein the prevention arrangement comprises an adjustment member for limiting the range of travel of the metering valve member.”** Applicants respectfully submit that this amendment finds full support in the originally filed specification, drawings or claims. Specifically, this limitation appears in originally filed claim 5.

Applicants respectfully submit that currently amended claim 1 is allowable over Greaney in view of Shipinski, for at least the reason that neither Greaney, Shipinski, nor any of the other cited references, alone or in combination, discloses, teaches or suggests a metering valve member having a range of travel including a region of dead travel in which substantially no variation in fuelling of the engine occurs, or a prevention arrangement that comprises an adjustment member for limiting the range of travel of the metering valve member. Thus, the present claims define an invention that is not obvious over Greaney, or Shipinski, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that discloses, teaches, hints or suggests the specific combination recited in the claims.

Accordingly, Applicants respectfully submit that the Examiner has failed to assert a *prima facie* case for obviousness, and the Section 103(a) rejection of claim 1 is improper. In other words, for at least for the reasons cited above, claim 1 is allowable. In addition, claims 2-4 and 11 depend from claim 1. Therefore, since claim 1 is allowable for the reasons set forth above, dependent claims 2-4 and 11 are also allowable.

Claim Objections

In the February 6, 2004, Office action, the Examiner objected to claims 5-10, 12-14, and 20 on the basis that they were dependent upon a rejected base claim, but indicated that they

would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

With respect to claims 5-10, which depend from claim 1, Applicants respectfully submit that claim 1, as amended, is allowable. As discussed above, Applicants have amended claim 1 to recite that **“the metering valve member has a range of travel including a region of dead travel in which substantially no variation in fuelling of the engine occurs, and wherein the prevention arrangement comprises an adjustment member for limiting the range of travel of the metering valve member.”** Applicants respectfully submit that this amendment finds full support in the originally filed specification, drawings or claims. Specifically, this limitation appears in originally filed claim 5.

Applicants respectfully submit that currently amended claim 1 is allowable over Greaney in view of Shipinski, for at least the reason that neither Greaney, Shipinski, nor any of the other cited references, alone or in combination, discloses, teaches or suggests a metering valve member having a range of travel including a region of dead travel in which substantially no variation in fuelling of the engine occurs, or a prevention arrangement that comprises an adjustment member for limiting the range of travel of the metering valve member. Thus, the present claims define an invention that is not obvious over Greaney, or Shipinski, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that discloses, teaches, hints or suggests the specific combination recited in the claims.

Accordingly, Applicants respectfully submit that claim 1 is allowable. In addition, claims 5-10 depend from claim 1. Therefore, since claim 1 is allowable for the reasons set forth above, dependent claims 5-10 are also allowable. On this basis, reconsideration and withdrawal of the objections to claims 5-10 is respectfully requested.

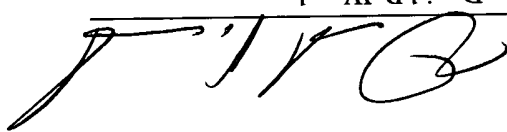
With respect to claims 12-13, Applicants have rewritten claim 12 in independent form, including all of the limitations of the base claim 1 and intervening claim 11, from which claim 12 had depended. Accordingly, Applicants respectfully submit that claim 12 is allowable. In addition, claim 13 depends from claim 12. Therefore, since claim 12 is allowable for the reasons set forth above, dependent claim 13 is also allowable. On this basis, reconsideration and withdrawal of the objections to claims 12-13 is respectfully requested.

With respect to claims 14 and 20, Applicants have rewritten claim 14 in independent form, including all of the limitations of the base claim 1, from which claim 14 had depended. Accordingly, Applicants respectfully submit that claim 14 is allowable. In addition, claim 20 depends from claim 14. Therefore, since claim 14 is allowable for the reasons set forth above, dependent claim 20 is also allowable. On this basis, reconsideration and withdrawal of the objections to claims 14 and 20 is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants request the withdrawal of the objection to claims 5-10, 12-14, and 20 and the rejections of claims 1-4 and 11. Applicants respectfully submit that all of the pending claims fully comply with 35 U.S.C. § 112 and are allowable over the prior art of record. Reconsideration of the application and allowance of all pending claims is earnestly solicited. Accordingly, the Examiner is requested to reconsider and allow claims 1-14 and 20 and pass the case to issue. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, the Examiner is invited to contact the undersigned at the Examiner's convenience. Please charge any necessary fees, including any extension of time, or any other fee deficiencies to Delphi Technologies, Inc., Deposit Account No. 50-0831.

Respectfully submitted,

By: 

David P. Wood
Registration No: 45,932
Attorney for Applicant
Phone No. 248-813-1202
Fax No. 248-813-1222